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Remarks

Applicants hereby add claims 21-25. Accordingly claims 1-25 are pending in the present application.

Claims 1-20 stand rejected under 35 USC 102(a) for anticipation by U.S. Patent Publication No. 2004/0204986 to Shimbori et al.

Applicants respectfully request reconsideration of the rejections.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8<sup>th</sup> ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements of the prior art must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to claim 1, Applicants respectfully submit that the teachings of the prior art are not arranged as defined in the claim and the 102 rejection is improper in view of the above-recited authority. In particular, the claim positively recites *monitoring an association of a consumable with an image forming device and enabling communication of the marketing message to the image forming device user responsive to the monitoring.*

The Office relies upon the teachings of paragraphs 44 and 42 of Shimbori as allegedly disclosing the claimed monitoring and enabling, respectively. However, paragraph 42 of Shimbori fails to teach the claimed *enabling communication of the marketing message to the image forming device user responsive to the monitoring.* Initially, paragraph 42 merely discusses operations after an ad is printed and fails to disclose or suggest enabling communication of a marketing message to a user responsive to monitoring of the association of the consumable with the image forming device. Paragraph 44 generically teaches checking a remaining amount of consumable and *placing an order to avoid lack of consumable items* and is void of any teachings regarding monitoring of an association of the consumable with the device. Paragraph 41 of Shimbori merely teaches that a cost required for printing an ad is charged to apparatus 60 when the ad is printed but is void of any teaching of what provides the printing of the ad or that printing of an ad is responsive to the teachings of paragraph 44.

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Applicants respectfully submit, for at least the above-mentioned reasons, the Office has failed to establish a proper 102 rejection in view of the above authority and the rejection of claim 1 is improper. Applicants respectfully request allowance of claim 1 in the next Action.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 2, the Office at page 3 of the Action relies upon the teachings of paragraph 44 in support of the rejection. However, paragraph 44 merely discloses that the consumable ordering apparatus 20 checks the remaining amount of consumable and places an order. The checking of paragraph 44 fails to teach or suggest *monitoring of a coupling of the consumable and the image forming device* as claimed and claim 2 is allowable for this additional reason.

Referring to independent claim 8, the method recites *providing a consumable usable to enable a marketing function with respect to image forming device users*. At page 4 of the Action, Office relies upon the teachings of paragraph 40 as allegedly teaching the claimed providing. The only reference in paragraph 40 to a consumable is with respect to the consumable ordering apparatus 20 and Applicants have failed to uncover any teaching of the claimed providing of the consumable usable to enable the marketing function as claimed. The providing is not disclosed nor suggested by the prior art and claim 8 is allowable for at least this reason.

Further, the Office relies upon the teachings of paragraph 41 as allegedly disclosing the claimed receiving of the indication of claim 8. Applicants have failed to uncover any teaching in paragraph 41 of receiving an indication regarding a desirous party to utilize the marketing function which is enabled by the consumable as defined in claim 8. Claim 8 is allowable for this additional reason.

Additionally, the Office relies upon paragraph 41 as allegedly teaching the claimed enabling. Paragraph 41 teaches a method of monitoring cost for printing an advertisement and fails to disclose or suggest the claimed *enabling the marketing function using the consumable*. The Office has failed to provide any explanation as to how Shimbori is to be considered to teach the claimed enabling using the

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consumable.

Applicants respectfully submit the numerous above-identified limitations of claim 8 are not disclosed nor suggested by the prior art and claim 8 is allowable for at least this reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 14 recites (in combination with claims 8 and 12) detecting a triggering event comprising detecting coupling of the consumable with the image forming device and the initiating the marketing function is responsive to the detecting. The Office relies upon the teachings of paragraph 44 as allegedly teaching the claimed detecting coupling. However, paragraph 44 teaches checking a remaining amount of consumable and placing an order to avoid a lack of the consumable void of the claimed detecting coupling of the consumable or initiating responsive to the detecting of the coupling. Claim 14 is allowable for this additional reason.

Referring to claim 16, Applicants have failed to uncover any teaching in paragraphs 15-16 of Shimbori relied upon by the Office as teaching the claimed limitations of the consumable comprising a memory device configured to store a marketing message. Applicants have failed to uncover any teaching in paragraph 42 of the claimed storing the marketing message using the memory device of the consumable. Applicants have failed to uncover any teaching in paragraph 42 of the claimed accessing the marketing message from the memory device. Claim 16 is allowable for these numerous reasons.

Referring to claim 17, the Office has tortured the meaning of commonly understood terms to arrive at the anticipation rejection. The Office alleges that the printer is a consumable. The interpretation by the Office is contrary to the explicit teachings of the specification of the pending application for example at paragraph 22 stating the consumables are used to form hard images and include media, marking agents, components having fixed life spans and other expendable items. In addition, claim 17 (read in conjunction with claim 8) recites providing a consumable usable in the image forming device. The Office's interpretation of the printer of

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Shimbori being a consumable is non-sensical as the claim under the Office's interpretation recites a printer usable in a printer. The Office's interpretation is contrary to the clear usage of consumable in the art and Applicants' application and the claimed consumable comprising a memory device is not disclosed nor suggested by the prior art. Furthermore, the use of memory device in claim 17 is consistent with well-understood meanings of memory understood in the art and is not "very broad" to include paper as alleged by the Office on page 6 of the Action. The Office has pointed to no teaching that Applicants intend the memory device of claim 17 to be broader than the ordinarily understood meaning of memory or memory device. The Office has pointed to no evidence that memory has ever been interpreted to include paper. Shimbori further fails to teach or suggest the claimed first communicating the identifier, *receiving the marketing message within the image forming device responsive to the first communicating*, and the second communicating the marketing message using the image forming device. Claim 17 is allowable for the numerous compelling above-identified reasons.

Referring to independent claim 20, the method recites *providing a consumable usable to enable communication of a marketing function with respect to image forming device users*. At page 4 of the Action, Office relies upon the teachings of paragraph 40 as allegedly teaching the claimed providing. The only reference in paragraph 40 to consumable is with respect to the consumable ordering apparatus 20 and Applicants have failed to uncover any teaching of the claimed providing of the consumable usable to enable communication of the marketing function as claimed. The providing is not disclosed nor suggested by the prior art and claim 20 is allowable for at least this reason.

At page 8 of the Action, the Office relies upon the teachings of paragraph 41 as allegedly disclosing the claimed receiving of the indication regarding a desirous party to utilize the marketing message. Applicants have failed to uncover any teaching in paragraph 41 of receiving an indication regarding a desirous party to utilize the marketing function which is enabled by the consumable as defined in claim 20. Claim 20 is allowable for this additional reason.

The Office identifies paragraph 73 as allegedly teaching the claimed detecting and initiating of claim 20. Paragraph 73 teaches a method of preventing printing with point after a predetermined number of sheets on which the printing

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with point was performed. Applicants have failed to uncover any teaching of the claimed *initiating communication of a marketing message using the printer responsive to the detecting the triggering event with respect to the consumable*. The notification of paragraph 73 may not be fairly considered to teach or suggest the claimed marketing message.

Numerous limitations of claim 20 are not disclosed nor suggested by the prior art and claim 20 is allowable for at least this reason.

Support for the new claims and amendments is provided at least by Figs. 2-3 and 5-6 and the associated teachings of the specification.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,  
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